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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,304	02/06/2001	Casey S. Pontenzone	7957-055	5699

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EXAMINER	
NGUYEN, QUANG N	
ART UNIT	**PAPER NUMBER**
2141	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/777,304	PONTENZONE ET AL.	
	Examiner	Art Unit	
	Quang N. Nguyen	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

1. This Office Action is responsive to the Amendment filed 07/06/2007. Claims 1, 4 and 6 have been amended. Claims 1-8 remain pending for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 2001/0053944 A1), hereinafter "Marks", in view of Dwek (US 6,248,946).

4. As to claims 1-2, **Marks** teaches a system for managing the delivery of content over a network to a user comprising:

a station and playlist module for managing the content delivered by one or more (a plurality of) stations over the network *(i.e., a station affiliated with a network of associated stations provides a top channel of programming which includes a default playlist)*, **(Marks, Abstract, paragraphs [0044-0046] and [0075])** the type of content

delivered by each of the stations being specified by a playlist for that station, wherein at least one of said stations includes two or more playlists and only one of said two or more playlists specifies the content delivered by that station at any one time *(i.e., the station's main/default playlist "Top Channel" and one or more distinct side channels of personalized programming)* **(Marks, Abstract, paragraphs [0017], [0044-0046] and [0075])**.

However, **Marks** does not explicitly teach the user may add content to at least one of the two or more playlists associated with the at least one station.

In an analogous art, **Dwek** teaches a system and method for delivering multimedia content to users over a computer network such as the Internet, wherein the media player includes a user interface that allows a user to search an online database of media selections and build a custom playlist exactly music selections desired by the user **(Dwek, Fig. 3A and Abstract, col. 7, lines 5-17 and col. 8, lines 27-49)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the feature of adding content to at least one of the two or more playlists associated with the at least one station, as disclosed by **Dwek**, into the teachings of **Marks**, since both references are directed to audio content delivery systems, hence, would be considered to be analogous based on their related fields of endeavor. One would be motivated to do so to provide the user/listener the total flexibility to select a list of any songs, or entire compact disc recordings, etc., in order to build a custom playlist of exactly the music selections desired by the user/listener **(Dwek, Abstract)**.

5. As to claim 3, **Marks-Dwek** teaches the system of claim 1, wherein the network is the Internet **(Marks, paragraph [0017])**.

6. As to claim 4, **Marks-Dwek** teaches the system of claim 1, wherein the content is audio-based and each playlist includes a number of songs delivered by the station associated with that playlist **(Marks, paragraphs [0012] and [0075])**.

7. As to claim 6, **Marks-Dwek** teaches the system of claim 1, wherein the content is multimedia-based and each playlist includes a number of music videos delivered by the station associated with that playlist **(Marks, paragraph [0030])**.

8. As to claims 7-8, **Marks-Dwek** teaches the system of claim 1, wherein the system further comprises a promotions module for managing promotional/advertising content to be included in the playlists **(Marks, paragraphs [0039] and [0094])**.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks-Dwek, in view of Rouchon (US 2001/0025259 A1).

10. As to claim 5, **Marks-Dwek** teaches the system of claim 4, but does not explicitly teach verifying a playlist contains at least one combination of songs that are in compliance with a set of licensing rules.

In an analogous art, **Rouchon** teaches a system and method for distributing digital music to listeners over a public computer network, wherein the radio station that agrees to air or distribute the songs will sign an exclusive contract with the artists, mentioning information such as price of the song, percentage of profit share between the artist, radio station, and copyright restriction *(i.e., songs are in compliance with a set of licensing rules)* **(Rouchon, paragraphs [0015] and [0051])**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the feature of verifying that a playlist contains at least one combination of songs that are in compliance with a set of licensing rules, as disclosed by **Rouchon**, into the teachings of **Marks-Dwek**, since both references are directed to multimedia content delivery systems, hence, would be considered to be analogous based on their related fields of endeavor. One would be motivated to do so to promote a music band awareness and popularity, to allocate payment of royalties or license fees to owners of rights in the audio files, and also to secure publishing and distribution rights without violate the copyright restrictions **(Rouchon, paragraph [0056])**.

Response to Arguments

11. In the Remarks, Applicants argued in substance that

(**A**) "Even if *Dwek* be deemed to show adding selections to a playlist, to combine its teaching with *Marks et al.* is in appropriate in view of *Marks et al.*'

affirmative teaching that it is a "hit the ground running" system, which allows a user to mold a station's playlist without requiring him to seek or pick any program selections. See paragraph [0048]. Thus, *Marks et al.* teaches away from a system in which, as in Dwek, a user makes selections to be added to a playlist", as recited in page 5 of the Remarks.

As to point (**A**), in response to applicant's argument that *"... Marks et al. teaches away from a system in which, as in Dwek, a user makes selections to be added to a playlist"*, Examiner respectfully disagrees noting that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, *Marks et al.* teaches **a method and system for searching, selecting, and playing audio program playlists**, wherein a listener can switch between different channels of any station, a top channel of general programming, and one or more distinct side channels of personalized programming if the listener has modified a playlist of that station to cause a side channel to be created **(Marks et al., Abstract)**. Specially, *Marks et al.* does teach a method and system allowing the listener **using the Category dial controls the top level subjects** and **the Channel dial can select different channels within a station if they are available**, wherein the categories may be the names of sites run by the network operator, or may describe

broadcast station locations (such as FM local, FM nation, and FM world) or local program sources such as a CD collection *(i.e., allowing the listener to search, select and play the desired audio program playlists)* **(Marks et al, paragraphs [0044-0046])**.

Hence, **Marks et al.** does teach a system and method allowing a user to personalize one or more playlists by searching and selecting program selections, thus **Marks et al.** does not teach away from a system in which, as in **Dwek**, a user makes selections to be added to a playlist.

12. Applicant's arguments as well as request for reconsideration filed on 07/06/2007 have been fully considered but they are not deemed to be persuasive.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Quang N. Nguyen
Patent Examiner
AU – 2141